

REMARKS

Request for Interview

Applicants respectfully request a personal interview with the Examiner to advance prosecution. Applicants would appreciate a telephone call from the Examiner prior to issuing an Office Action so that an interview may be arranged.

Status of the Claims

Claims 1-8 and 10-19 are pending in this application. No claims have been canceled. Claims 17 to 19 have been added. Support for new claim 17 is found in original claim 4. Support for new claim 18 is found in original claim 12. Support for new claim 19 is found in original claim 5. The claims have been amended to delete "derivative" and insert "compound". No new matter has been added by the above claim amendments.

Restriction Requirement

Applicants continue to traverse the restriction requirement. Applicants continue to submit that the Examiner is using an inappropriate standard for restricting the claims and requiring an election. Regarding the common structure analysis for finding no restriction, the Examiner states "the compounds are not regarded as being of similar nature because the shared common structure is not seen to be a contribution over the prior art." Applicants submit that the Examiner has pointed to no authority for applying this

standard. Moreover, the point of novelty has absolutely nothing to do with the common structure analysis in finding no restriction. Applicants respectfully request that the claim be rejoined.

Rejection under 35 USC 112, second paragraph

The Examiner rejects claims 1-7 and 12-14 as indefinite because the claims recite "derivatives". Applicants amend the claims to recite "compounds" instead of "derivates". As such, the subject matter of the claims has been distinctly claimed and the rejection should be withdrawn.

Rejection under 35 USC 102(b)

The Examiner continues to reject claims 1-7 and 12-14 as anticipated by Varaprasad et al. (Bioorganic Chem. Vol. 14, pages 8-16). Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants submit that the present invention is not anticipated by the cited art. The present invention is directed to an aminooxy-cyclodextrin compound and a method of preparing the same. The compound of claim 1 is a protected aminooxy compound, meaning that a protecting group protects the amino on the structure during a reaction and then the group can be removed after it has completed its protecting function.

Varaprasad discloses a hydroxamic acid compound, namely a N-hydroxy-succinic ester compound similar to the claimed compound of claim 1. However, Varaprasad fails to disclose such a protection group for the amino group.

The Examiner states that the arguments submitted in the Reply of June 25, 2002 are "intent to use" arguments. Applicants respectfully disagree and hereby incorporate by reference the arguments made in the Reply of June 25, 2002.

Applicants submit that the protection group of formula 1 in claim 1 is an element of the present invention. Since, Varaprasad fails to disclose a protection group for the amino group, Varaprasad fails to disclose all the elements of the present invention. As such, Varaprasad cannot anticipate the present invention.

Applicants submit that one of ordinary skill in the art would never classify the hydroxamic acid of formula II in Varaprasad as an amino protecting group. A protecting group is a group that is removable forming an amine group. Such amino protecting groups are formed by protonation, alkylation and acylation of the amine group. However, please note that the compound of formula II in Varaprasad is formed by a reaction between a carboxyl and an imide, and not an amine.

Moreover, there is no known way one of ordinary skill in the art could modify the compound of Varaprasad to obtain a free aminoxy group. Hydrolysis of the Varaprasad compound generates free hydroaminic acid (-X-Y-OH). In fact, the Varaprasad reference is directed to this very subject.

Applicants further submit that the above arguments also apply to new claims 17-19, which are also patentable over the cited prior art.

Since, Varaprasad fails to disclose or suggest all the elements of the present invention, Applicants respectfully request that the rejection be withdrawn as no prima facie case of anticipation has been established.

Conclusion


As Applicants have addressed and overcome all rejections in the Office Action, Applicants respectfully request that the rejections be withdrawn and that the claims be allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia Reynolds (Reg. No. 47,021) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

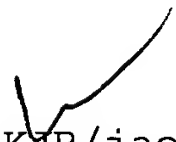
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By 

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